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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,739	09/26/2003	Bradley P. Lane	LANEB.65288	9450
27629	7590	11/18/2004	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP 200 OCEANGATE, SUITE 1550 LONG BEACH, CA 90802			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/672,739	LANE, BRADLEY P.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark T Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-15, 17, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-15, 17, 35 and 36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/26/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 16 and 18-34 have been canceled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2-15, 17, 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 2 recites the limitation "the pocket" in line 18. There is insufficient antecedent basis for this limitation in the claim.

3. Claim 5 recites the limitation "said positional indicator" in line 4. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 10 recites the limitation "the next positional indicator" in line 3. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 11 recites the limitation "said database record" in line 3. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 17 recites the limitation "said positional indicators" in line 14. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 21, 31 and 32 of copending Application No. 09/982,365. Although the conflicting claims are not identical, they are not patentably distinct from each other because both discloses a display apparatus comprising: a binder having cover members and a spine; a plurality of loose leaf pages, wherein the pages have a display section, a front side, back side, a common divider; a table of contents; and a plurality of post members.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7, 11-15, and 35, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Yankowski (5,751,672) and further in view of Hempleman et al (6,243,725).

Liener Chin et al discloses in Fig. 21-23, a method for organizing display related material comprising: selecting a display binder including looseleaf pages (Fig. 21) including pockets (910 in Fig. 23) with a transparent viewing panel (910A) for viewing a collectible display related materials, wherein the pocket has indicia (written in 920); and wherein display material is placed in the pocket; assigning positional identifiers (854); generating and attaching a table of contents (890 in Fig. 22) to the binder whereby a user may view the table of contents (750 in Fig. 21), select a desired title (790a) and note the positional identifier (750a), flip the sheets to select a pocket (910) corresponding with positional identifier; and wherein the pockets can be a 2x2 matrix (seen in Fig. 24 and 25).

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However, Liener Chin et al does not disclose providing an online database structured to store a listing of compact disc titles; selecting a title from the database; and generating a table of contents printout by selecting the collection of titles and positional identifiers.

Yankowski discloses in Fig. 5, an online database structured to store a listing of compact disc titles, wherein a title is selected from the collection of titles to form a collection of titles and associated positional identifiers (Col. 9, lines 55-67 and Col. 10, lines 1-3), and wherein the database further includes a track listing associated with the compact disc title.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's method of organizing with an online database as taught by Yankowski for providing a means to generate a particular listing.

However, Liener Chin et al as modified by Yankowski does not disclose wherein an online database that generates a printout.

Hempleman et al discloses in Fig. 1 wherein a database report printout can be generated (Col. 3, lines 37-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's and Yankowski's method of organizing with a generated printout of the database listing as taught by Hempleman et al for the purpose displaying the database on a hardcopy substrate.

In regards to **Claim 2**, wherein the online database is structured to store a master listing of compact titles; and wherein the display material is compact disc related material, a recitation of

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the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the display material of Liener Chin et al is capable of being compact disc related material; and the online database of Yankowski is capable of storing a master listing of compact disc titles.

In regards to **Claim 5**, wherein a track listing for at least one compact disc title is generated, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the generated listing of Hempleman is capable of being used for at least one compact disc title.

In regards to **Claim 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to search in as many databases as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious for the end user to search in any desirable number of remote databases to add compact disc titles, since applicant has not disclosed that a particular number of databases is critical to the invention, and invention would function equally as well with any number of online/remote databases.

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In regards to **Claims 11-15**, wherein a music category, compact disc classification, and artist category have been added to the database, mere claiming storage of facts or data which are to be read or outputted by a computer without creating any functional interrelationship as part of the computing process performed by the computer does not impart patentability. Therefore, it would be obvious to place any type of data categories or classification in the database, since the data items are just a mere arrangement of facts.

10. Claim 8, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Yankowski (5,751,672) and Hempleman et al (6,243,725), and further in view of Ho (5,501,540).

Liener Chin et al as modified by Yankowski and Hempleman et al disclose an online method of organizing comprising all the elements as claimed in Claim 2, and as set forth above. However, Liener Chin et al does not disclose wherein the display related material is a liner note.

Ho discloses in Fig. 4, a transparent pocket (34) comprising a liner note (341) stored in the pocket.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's, Yankowski's and Hempleman et al's method of organizing with a display related material being a liner note substrate stored in a pocket as taught by Ho for the purpose of holding supporting information.

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11. Claim 9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Yankowski (5,751,672) and Hempleman et al (6,243,725), and further in view of Ozeki (5,290,118).

Liener Chin et al as modified by Yankowski and Hempleman et al disclose an online method of organizing comprising all the elements as claimed in Claim 2, and as set forth above. However, Liener Chin et al does not disclose wherein the display related material is a liner note.

Ho discloses in Fig. 3, a transparent pocket (10) comprising a compact disc (8) stored in the pocket.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's, Yankowski's and Hempleman et al's method of organizing with a display related material being a compact disc stored in a pocket as taught by Ho for the purpose of displaying a particular disc to be used by the end user.

12. Claim 17, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Brosmith et al (5,692,607), and further in view of Hempleman et al.

Liener Chin et al discloses in Fig. 21-23, a display apparatus comprising: a binder (830) having an elongated spine member (830A) supporting along a longitudinal margin; hinge sections (830D) to connect the cover members (830B and 830C) to the spine (830A); a plurality of looseleaf pages (820) positioned between the covers and suspended from the spine, wherein each

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page includes a display section (910A in Fig. 23) having a front side and back side and bordering a perforated hinge section (820A in Fig. 21), and further having storage sleeves forming pockets (910 in Fig. 23) with an opening (A) along one side (A1), a viewing window (910A) for viewing a display item or sheet; wherein the pocket has indicia (written in 920); and wherein a display item is placed in the pocket; and a plurality of post members (830E); and wherein one of the pages displays a table contents (750 in Fig. 21); and whereby a user may refer to the table of contents listing to locate a selected display item, and flip the pages to the pocket having matching indicia to view the inserted display related material (Col. 11, lines 1-52).

However, Liener Chin et al does not disclose: a common divider formed of non-woven material; pocket indicia correlating the respective pockets to the respective positional identifiers; a table of contents generated from a subset of a database listing;

Brosmith et al discloses in Fig. 1-4, a looseleaf pages comprising a display section (12, 14, 16), wherein the display section has a pocket with a non-woven backing (14), a common divider (Fig. 1, which consist of backing (14)), and an opposing transparent window (12 and 16)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's display apparatus to include looseleaf pages with a display section having a pocket a backing and a common divider as taught by Brosmith et al for holding discs in a binder.

However, Liener Chin et al does not disclose a table of contents generated and inserted into the pockets correlating the compact disc titles with individual pocket indicia.

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Hempleman et al discloses in Fig. 1 wherein a database printout sheet can be generated (Col. 3, lines 37-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's and Brosmith et al's method of organizing with a generated display sheet of the database listing as taught by Hempleman et al for the purpose displaying the database on a hardcopy substrate.

In regards to **Claim 17**, mere claiming storage of facts or data which are to be read or outputted by a computer (table of contents generated from a subset of the database listing) without creating any functional interrelationship as part of the computing process performed by the computer does not impart patentability. Therefore, it would be obvious to obtain a display item (table of contents) from any type of database listing, since the data items form the database are just a mere arrangement of data or facts.

13. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liener Chin et al in view of Yankowski (5,751,672) and Hempleman et al (6,243,725), and in further view of Vinyard et al (6,265,043) and Bakke et al (6,135,662).

Liener Chin et al as modified by Yankowski and Hempleman et al discloses a method of organizing comprising all the elements as claimed in Claim 35, and as set forth above. However, Liener Chin et al does not disclose a first set of stickers which are placed on a respective pocket; and a second set of stickers placed on the collectible item.

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Vinyard et al discloses stickers which can be placed on a collectible items such as a compact disc.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's, Yankowski and Hempleman et al's method for organizing with a label on a collectible item such as a compact disc as taught by Vinyard et al for the purpose of describing the contents of the collectible item.

However, Liener Chin et al as modified by Yankowski, Hempleman et al and Vinyard et al does not disclose a sticker placed on a pocket.

Bakke et al discloses in Fig. 1 and 7, a label (104) placed in a pocket which is placed on top of a storage pocket (48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al's, Yankowski's, Hempleman's and Vineyard et al's method of organizing by providing a label placed and secured on a pocket as taught by Bakke et al for the purpose of labeling the pockets contents.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a pocket or sleeve in place of adhesive, since the examiner takes Official Notice of the equivalence of securing a label substrate by placing it in a pocket or sleeve to that of having adhesive placed on the substrates backside to secure it to an item, and the selection of any of these known equivalents to secure an item would be within the level of ordinary skill in the art.

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Furthermore, in regards to the stickers of the second set to correspond to the stickers of the first set, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the stickers from Bakke et al and Vinyard et al are capable of corresponding with each other.

***Allowable Subject Matter***

14. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Yankowski, Bellinger et al, Berry et al, Dockes et al, Wehmeyer, and Katz et al disclose similar methods and apparatuses of organizing.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

November 15, 2004

  
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